

PATENT / DOCKET NO.: 6643R5
CUSTOMER NO.: 030113

REMARKS

I. Status of Claims

Claims 1-4, 7-11, 13-15, 20, and 25 are pending.

II. Rejection of Claims under §103(a)

Claims 1-4, 7-11, 13-15, 20, and 25 were rejected as unpatentable over Ram *et al.* The description of compound #17 of Table 1 on page 541 of Ram as having "no data" was cited as not necessarily meaning that the compound has no antineoplastic activity, especially in light of a statement on page 543 of Ram *et al.* first column, where lines 1-8 of "Antitumor Results and Discussion" discloses that all compounds in Table 1 except for 13 and 18 showed cytotoxic activity against L1210 cells. The examiner maintains that substitution of the fluorine with hydrogen would have been obvious to one of skill in the art. The examiner maintains that the claimed compound and the compound of Ram share close structural similarity and one of ordinary skill in the art would reasonably expect the two compounds to have similar antineoplastic activity.

Response

Either the statement of Ram *et al.* on page 543, column 1 cited by the Office Action is false or the information of Table 1 regarding no data for compound #17 is false. One of skill in the art reading Ram *et al.* would not know which piece of information to believe.

The only instruction regarding fluoro derivatives of phenyl esters of Ram *et al.* are the data of carboxamide derivatives 28 and 29 of Table III and the fluorobenzamides 36 and 38 of Table IV. Derivatives 28 and 29 are inactive as demonstrated by the data of Table III and the statement on page 542 at column 2, lines 1-2 that states "The aromatic carboxamides 28 and 29 were devoid of activity." Derivative 36 (a *meta* fluoro derivative) was curative as stated by line 2, col. 1, page 543, and as demonstrated by Table IV. Derivative 38 (an *ortho* fluoro derivative) showed no activity as demonstrated by Table IV and by the statement at page 543, col. 1, line 3. Compound 37 (a *para* fluoro derivative) has no data in Table IV and is referred to as having no activity at line 3 of col. 1 of page 543. Therefore no conclusion can be gathered regarding compound 37.

Statements at col. 2, page 543, beginning at line 5 of the first full paragraph state "The position of the fluorine-substituent on the benzene ring appears to be important since *o*-fluoro compound 38 was significantly cytotoxic, while *meta* isomer 36 was completely inactive. As noted above, compounds 28 and 29 (Table III) with *p*-F and *p*-CF₃, respectively, were also totally inactive.

An "obvious-to-try" situation exists when a general disclosure may pique the scientist's curiosity, such that further investigation might be done as a result of the disclosure, but the disclosure

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itself does not contain a sufficient teaching of how to obtain the desired result or indicate that the claimed result would be obtained if certain directions are pursued. *In re Eli Lilly & Co.* 14 USPQ2d 1741, 1743 (Fed. Cir. 1990).

Applicants submit that *Ram et al.* presents an "obvious-to-try" situation, however, it has been well established that "obvious-to-try" is not the same as "obviousness" under 35 USC 103 *Ex parte Old*, 229 USPQ 196 (BPAI 1985).

The Federal Circuit has required that specific support must be found in the prior art that "suggests" or "teaches" the modification necessary to resolve the differences of the prior art with a claimed invention. *In re Grabiak*, 226 USPQ 870 (Fed. Cir. 1985). Applicants submit that no such support for making the structural and chemical changes to compound #17 of *Ram et al.* necessary to resolve the differences with the claimed invention is present in *Ram, et al.*

Since *Ram et al.* do not render the compound claims obvious, *Ram et al.* cannot render claims to compositions relating to the compound obvious. Applicants respectfully request that this rejection be withdrawn.

III. Conclusion

It is believed that all matters of the Office Action have been addressed. Reconsideration and an early indication of the allowability of the claims are earnestly requested. Should the Examiner have any questions, comments or suggestions that would expedite the prosecution of the present case to allowance, Applicants' undersigned representative earnestly requests a telephone conference at (512) 867-8528.

Respectfully submitted,

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